

REMARKS

This amended is presented prior to the examination of the continuation patent application identified above. This amendment presents claims that were examined, but not allowed, in the parent application, 09/991,314.

By the forgoing amendment, claims 1-32 are cancelled, and new claims 33-50 are added. Thus, claims 33-50 are currently pending for examination.

Claims 33-42 correspond to claims 9-18 in the parent application, 09/991,314.

Claims 44-50 correspond to claims 33-39 in the parent application, 09/991,314.

During prosecution of the parent application, 09/991,314, the claims now presented in this application were rejected 35 U.S.C. § 112, first paragraph, and 35 U.S.C. §§ 102(b) and 103(a). Consequently, Applicant will respond to those rejections as follows.

Claims 44-50 (previously claims 33-39) were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not enabled by the specification. Specifically, it was alleged that claim 44 “recites an ink having an electrical charge and the electrical charge facilitates transfer of the image to the print medium but the specification does not describe how the electrical charge get [sic] into the ink or how the ink has been charged. . . . One of ordinary skill in the art could not know how the ink has been charged.” (Paper No. 9, p. 2). This is clearly incorrect.

In the same Office Action, it was alleged that U.S. Patent No. 5,365,261 to Ozawa et al. (“Ozawa”) teaches the use of a charged ink. (Paper No. 9, p. 3). Thus, it is clear that charged inks are known in the prior art. It is impossible for the prior art to teach the use of a

charged ink *and* for Applicant's recitation of using a charged ink to be beyond the ability of one skilled in the art, i.e., not be enabled.

"A patent need not teach, and preferably omits, what is known in the art." *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987). Paragraph 63 of Applicant's specification describes the use of charged ink. It is not necessary for Applicant's specification to then describe all the possible methods of charging the ink because such techniques are known in the art, as demonstrated, for example, by the Ozawa reference.

Consequently, the rejection of claims 44-50 under 35 U.S.C. § 112, first paragraph, was clearly improper and should be repeated in this continuation application.

With regard to the prior art, the claimed invention was rejected in examination of the parent application as anticipated under 35 U.S.C. § 102(b) by Ozawa or under 35 U.S.C. § 103(a) as unpatentable over the teachings of Ozawa in combination with a number of other respective prior art references. For at least the following reasons, these rejections are respectfully traversed.

Claim 33 (previously claim 9) recites:

A method of printing with an inkjet printing system, said method comprising:
providing a supply of liquid ink comprising a carrier fluid;
using said ink, printing an image with an inkjet print head on a transfer member that is adjacent to said print head and moveable with respect to said print head;
evaporating some of said carrier fluid from said image as said transfer member moves between said inkjet print head and a position at which said image is transferred from said transfer member to a sheet of print medium; and

transferring said printed image from said transfer member to a sheet of print medium;

wherein said method does not include curing said ink with electromagnetic radiation.

(emphasis added).

In contrast, Ozawa fails to teach or suggest the step of evaporating some of the carrier fluid while the image is on a transfer member. As shown in Figs. 3 and 4, Ozawa teaches the addition of charged ions (143) on the surface of the solvent or carrier fluid (142). It is Applicant's position that these ions prevent the evaporation of the carrier fluid, at least during the period of time the carrier fluid is disposed on the transfer member. These ions (143) deform the shape of the solvent (142), separate the solvent from the coloring particles (141) and hold the solvent in the new shape as shown in Fig. 4. According to Ozawa, "the solvent 142 decreases in the direction of height of the ink image 140 and simultaneously expands in proportion to the contact area between the ink image 140 and the transfer drum 111." (Col. 6, lines 18-22). The solvent (142) is reshaped, no evaporation occurs.

Later on, the Ozawa reference states that the solvent (142), which has not evaporated, "quickly soaks into the recording paper 121." (Col. 6, lines 44-45). It is important to the Ozawa system that the solvent (142) not evaporate, but rather soak into the recording paper. (Col. 6, lines 47-55).

This is expressly contrary to Applicant's invention in which it is desired to prevent the solvent or carrier fluid from being absorbed by the paper or print medium. (Applicant's specification, para. 13). According to Applicant's specification, "the carrier fluid, when it contacts the print medium, causes the print medium to swell or deform. This is particularly true if the carrier fluid is absorbed by the print medium, but also occurs if the carrier fluid is

evaporated from the print medium. This localized swelling of the print medium fibers is a phenomenon known as ‘cockle.’” (Applicant’s, specification, para. 10). One of the benefits of Applicant’s claimed systems is the ability to decrease cockle. (*See*, Applicant’s abstract).

Consequently, Ozawa fails to teach or suggest all the features of claim 33.

Specifically, Ozawa fails to teach or suggest evaporating some of the carrier fluid while a printed image is residing on a transfer member. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *See* M.P.E.P. § 2131. Therefore, a rejection of claim 33 based on Ozawa would insufficient and should be repeated in this continuation patent application.

Claim 44 (previously claim 33) recites:

An inkjet printing system comprising:
ink comprising a carrier fluid and having an electrical charge;
an inkjet print head using said ink for printing images on a transfer member that is adjacent to said print head and moveable with respect to said print head; and
said transfer member disposed to transfer said images to a print medium;
wherein said electrical charge facilitates transfer of said images to the print medium.

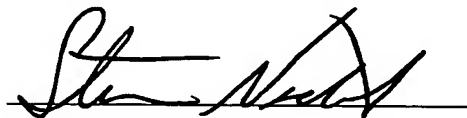
In contrast, Ozawa fails to teach or suggest an electrical charge that “facilitates transfer of said images to the print medium.” Rather, as explained above, Ozawa teaches a charged ink that is used to separate the charged coloring particles (141) from the solvent (142). This is done so that the solvent can be absorbed into the print medium before the image (i.e., the

color particles (141) are transferred to the print medium. This allegedly reduces bleeding of the image *after* the image has been transferred to the print medium. (Col. 6, lines 47-55).

Consequently, the charge in the ink (140) taught by Ozawa is not used and does not facilitate the actual transfer of the image to the print medium as recited in claim 33. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, a rejection of claim 44 based on Ozawa would be insufficient and should not be repeated in this continuation patent application.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

DATE: 9 July 2003

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066 • (801) 572-7666 (fax)